UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,955	11/21/2003	Tsutomu Taniguchi	60256 (70904)	3521

21874 7590 05/27/2009
EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER	
ROBINSON, MYLES D	

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
05/27/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/719,955	TANIGUCHI ET AL.	
	Examiner	Art Unit	
	Myles D. Robinson	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 3, 6, 7, 9, 12 - 16, 19 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3, 6, 7, 9, 12 - 16, 19 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 August 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 3/5/2009, and has been entered and made of record. Currently, **claims 1, 3, 6, 7, 9, 12 – 16, 19 and 20** are pending.

Response to Arguments

2. Applicant's arguments with respect to **claims 1, 3, 6, 7, 9, 12 – 16, 19 and 20** have been considered but are moot in view of the new ground(s) of rejection.

3. The indicated allowability of **claims 2, 3, 8, 9 and 13 – 16** is withdrawn in view of the newly discovered reference(s) to **Voticky *et al.*** (U.S. Patent No. 6,351,764), **Eggleston *et al.*** (U.S. Patent No. 5,764,899) and **Haneda *et al.*** (U.S. Patent No. 6,189,027). Rejections based on the newly cited references follow.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. ***Claims 13, 14 and 19*** are rejected under 35 U.S.C. 102(b) as being anticipated by **Voticky *et al.*** (U.S. Patent No. 6,351,764).

Referring to **claim 13**, Voticky discloses a communications device (*see Fig. 1, client 8 [column 2, line 64 – column 3, line 9*) transmitting/receiving data over a network (*see Fig. 1, communications network 2 [column 3, lines 10 – 15 and 44 – 51]*) and

making a request for a response to a data transmission from a receiving-end machine, said device comprising:

data identifying means for determining whether data to be received over the network is response data to the response request (*see Fig. 2 wherein identifiers of the source of information expected to be received by client 8 are entered in step 14 [column 4, lines 14 – 36 and column 5, lines 34 – 37]*), and

receipt control means for ranking, concerning receiving of data (*see Fig. 2, step 20 [column 4, lines 51 – 54, column 4, lines 43 – 57 and column 7, lines 36 – 41]*), data identified as the response data by the data identifying means higher than other data (*column 6, lines 36 – 45, column 7, lines 30 – 35 and column 8, lines 35 – 39*).

Referring to **claim 14**, Voticky discloses the device further wherein:

the communications device transmits/receives data through the network and a relay device (*see Fig. 1, server 6 [column 3, lines 10 – 19]*), the relay device receiving and storing data addressed to the communications device over the network and for assigning identity information and a serial number to each of stored data sets, the stored data sets being renumbered where necessary so that they are serially numbered (*column 7, lines 11 – 18 wherein the PAC numbers, which are serially organized from A1100 through A1394 in this example, are assigned to and prioritize received messages*), and

when data is to be received from the relay device, the receipt control means changes a data receiving ranking by way of a request to the relay device from a ranking indicated by the serial numbers (*see Fig. 1 wherein server 6, which has the identical*

functionality of client 6, filters or discriminates for prioritizing e-mail messages [column 3, line 52 – column 4, line 6]).

Referring to **claim 19**, the rationale provided above in rejection of claim 13 is incorporated herein. The apparatus of claim 13 performs the method steps stored as a program of instructions of claim 13 within memory and executed by one or more processors (*see Fig. 1, server 6, client 8 [column 2, line 64 – column 3, line 9 and column 3, line 61 – column 4, line 6]*).

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. ***Claims 1, 6, 7, 12 and 20*** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eggleston *et al.*** (U.S. Patent No. 5,764,899).

Referring to **claim 7**, Eggleston discloses a communications device (*see Figs. 1 – 2 wherein mobile station (MS) 105, which may be one or more user devices such as wireless subscriber units, communicates with host processor 115 [column 4, lines 4 – 11]*), comprising:

transmission/receipt means for transmitting/receiving data over a network (*see Figs. 1 – 2, network 130 [column 2, lines 59 – 65 and column 4, lines 4 – 51]*),

response request embedding means for embedding a response request for a response to a data transmission from a receiving end machine in transmitted data (*see*

Fig. 9 wherein responses to earlier data transmissions [e.g. prior e-mails] are optimized for transmission [column 11, lines 37 – 47]),

data identifying means for determining whether data to be received over the network is response data to the response request by comparison (*see Fig. 9 wherein a reply message to a preceding message is identified through comparison matching of extracted text in steps 918 – 930 [column 13, lines 31 – 46 and 53 – 55]*), and

receipt control means for controlling receipt so as to preferentially receive data identified as the response data by the data identifying means over other data (*see Fig. 9 wherein the message sizes of responses to earlier data transmissions [e.g. mail messages] are minimized if they exceed the threshold [i.e. generated delta] of an optimized reply [Abstract, column 3, lines 35 – 56, column 9, lines 37 – 47, column 9, line 61 – column 12, line 8]*) but does not explicitly disclose the device further wherein the determination of response data by comparing a size of the data to be received to a predetermined data size.

However, in another embodiment, Eggleston does disclose the device comparing a size of the received response data to a predetermined data size, such that the identified response data is received preferentially (*see Fig. 5 wherein the host server filters a response to a preceding client generated message based upon applied filters beginning in step 502 and then the message size of the response is compared to a maximum size threshold in step 508 such that messages exceeding the threshold are treated differently than messages meeting the criteria [e.g. reject] [column 7, line 59 – column 8, line 2, column 8, lines 16 – 33, 58 – 59 and column 9, lines 62 – 67]*).

The teachings within Eggleston are combinable because they are two separate embodiments yet from the same field of endeavor. At the time of the invention, it would have been obvious to one of ordinary skill in the art to substitute the comparison matching of text of response messages taught by Eggleston for the comparison matching of size of response messages taught by Eggleston without yielding an unexpected result. Since each individual element and its function are shown in the prior art, albeit shown in separate embodiments within the same reference, the difference between the claim and that of the prior art rests not on any individual element or function yet relies on the very combination itself, namely the substitution of text comparison for size comparison. Because both text comparison and size comparison are applied to response message data to determine preferred handling methods (e.g. message filtering), one of ordinary skill in the art would determine that this mere substitution of one element for another known in the field would yield predictable results. The suggestion/motivation for applying such a combination of reject/pass filter criteria would have been to allow the user to determine preferred handling methods, especially when avoiding more expensive and time-consuming transmissions (i.e. transmissions related to available bandwidth and message sizes), as suggested by Eggleston (*column 1, lines 50 – 67 and column 8, lines 44 – 57*).

Referring to **claim 1**, the rationale provided in the rejection of claim 7 is incorporated herein. In addition, claim 7 embodies the limitations and elements of those in claim 1.

Referring to **claim 20**, the rationale provided in the rejection of claim 1 is incorporated herein. In addition, the apparatus of claim 1 performs the method of claim 20.

Referring to **claims 6 and 12**, the rationale provided above in rejections of claims 1 and 7, respectively, are incorporated herein. The apparatuses of claims 1 and 7 perform the methods steps stored as programs of instructions of claims 6 and 12, respectively, within memory and executed by one or more processors (*see Fig. 1, mobile station (MS) 105, host processor 115, communications server 110, CD-ROM 107 [column 4, lines 16 – 29]*).

8. ***Claim 15*** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Voticky *et al.*** (U.S. Patent No. 6,351,764) in view of **Eggleston *et al.*** (U.S. Patent No. 5,764,899).

Referring to **claim 15**, Voticky discloses the device as discussed above in the rejection of claim 13 but does not explicitly disclose the device further wherein the data identifying means determines whether data to be received is the response data by comparing a size of the data to be received to a predetermined data size.

Eggleston discloses a communications device (*see Figs. 1 – 2 wherein mobile station (MS) 105, which may be one or more user devices such as wireless subscriber units, communicates with host processor 115 [column 4, lines 4 – 11]*) transmitting/receiving data over a network (*see Figs. 1 – 2, network 130 [column 2, lines 59 – 65 and column 4, lines 4 – 51]*) and making a request for a response to a data

transmission from a receiving end machine in transmitted data (*see Fig. 9 wherein responses to earlier data transmissions [e.g. prior e-mails] are optimized for transmission [column 11, lines 37 – 47]*), said device comprising:

data identifying means for determining whether data to be received over the network is response data to the response request by comparison (*see Fig. 9 wherein a reply message to a preceding message is identified through comparison matching of extracted text in steps 918 – 930 [column 13, lines 31 – 46 and 53 – 55]*), and

receipt control means for controlling receipt so as to preferentially receive data identified as the response data by the data identifying means over other data (*see Fig. 9 wherein the message sizes of responses to earlier data transmissions [e.g. mail messages] are minimized if they exceed the threshold [i.e. generated delta] of an optimized reply [Abstract, column 3, lines 35 – 56, column 9, lines 37 – 47, column 9, line 61 – column 12, line 8]*) but does not explicitly disclose the device further wherein the determination of response data by comparing a size of the data to be received to a predetermined data size.

However, in another embodiment, Eggleston does disclose the device comparing a size of the received response data to a predetermined data size, such that the identified response data is received preferentially (*see Fig. 5 wherein the host server filters a response to a preceding client generated message based upon applied filters beginning in step 502 and then the message size of the response is compared to a maximum size threshold in step 508 such that messages exceeding the threshold are*

treated differently than messages meeting the criteria [e.g. reject] [column 7, line 59 – column 8, line 2, column 8, lines 16 – 33, 58 – 59 and column 9, lines 62 – 67]).

The teachings within Eggleston are combinable because they are two separate embodiments yet from the same field of endeavor. At the time of the invention, it would have been obvious to one of ordinary skill in the art to substitute the comparison matching of text of response messages taught by Eggleston for the comparison matching of size of response messages taught by Eggleston without yielding an unexpected result. Since each individual element and its function are shown in the prior art, albeit shown in separate embodiments within the same reference, the difference between the claim and that of the prior art rests not on any individual element or function yet relies on the very combination itself, namely the substitution of text comparison for size comparison. Because both text comparison and size comparison are applied to response message data to determine preferred handling methods (e.g. message filtering), one of ordinary skill in the art would determine that this mere substitution of one element for another known in the field would yield predictable results. The suggestion/motivation for applying such a combination of reject/pass filter criteria would have been to allow the user to determine preferred handling methods, especially when avoiding more expensive and time-consuming transmissions (i.e. transmissions related to available bandwidth and message sizes), as suggested by Eggleston (*column 1, lines 50 – 67 and column 8, lines 44 – 57*).

Voticky and Eggleston are combinable because they are from the same field of endeavor, being e-mail organization systems. At the time of the invention, it would have

been obvious to one of ordinary skill in the art to include filtering e-mails in such messaging systems based upon bandwidth and message sizes. The suggestion/motivation for doing so would have been to determine preferred handling methods, especially when avoiding more expensive and time-consuming transmissions, as suggested by Eggleston (*column 1, lines 50 – 67 and column 8, lines 44 – 57*).

9. ***Claims 3 and 9*** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eggleston *et al.*** (U.S. Patent No. 5,764,899) in view of **Haneda *et al.*** (U.S. Patent No. 6,189,027).

Referring to **claim 9**, Eggleston discloses the device as discussed above in the rejection of claim 7 but does not explicitly disclose the device further comprising storage means for storing received data, and storage control means for controlling storing to the storage means so that after storing the received data, the storage means is left with empty space needed to store the response data.

Haneda discloses the device comprising:

storage means (*see Fig. 1, storage section 6 [column 3, lines 37 – 48]*) for storing received data, and

storage control means (*see Fig. 1, host computer 1*) for controlling storing to the storage means so that after storing the received data, the storage means is left with empty space needed to store the response data (*column 1, lines 27 – 58, column 2, lines 5 – 15 and column 3, lines 15 – 33*).

Eggleston and Haneda are combinable because they are from the same field of endeavor, being e-mail systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include memory management along with such e-mail systems. The suggestion/motivation for doing so would have been to secure sufficient memory capacity for urgent or important e-mails while providing an easy, convenient memory management scheme for the user, as suggested by Haneda (*column 1, lines 43 – 58 and column 2, lines 12 – 15*).

Referring to **claim 3**, the rationale provided in the rejection of claim 9 is incorporated herein. In addition, claim 9 embodies the limitations and elements of those in claim 3.

10. ***Claim 15*** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Voticky *et al.*** (U.S. Patent No. 6,351,764) in view of **Haneda *et al.*** (U.S. Patent No. 6,189,027).

Referring to **claim 16**, Voticky discloses the device as discussed above in the rejection of claim 7 but does not explicitly disclose the device further comprising storage means for storing received data, and storage control means for controlling storing to the storage means so that after storing the received data, the storage means is left with empty space needed to store the response data.

Haneda discloses the device comprising:

storage means (*see Fig. 1, storage section 6 [column 3, lines 37 – 48]*) for storing received data, and

storage control means (*see Fig. 1, host computer 1*) for controlling storing to the storage means so that after storing the received data, the storage means is left with empty space needed to store the response data (*column 1, lines 27 – 58, column 2, lines 5 – 15 and column 3, lines 15 – 33*).

Voticky and Haneda are combinable because they are from the same field of endeavor, being e-mail systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include memory management along with such e-mail systems. The suggestion/motivation for doing so would have been to secure sufficient memory capacity for urgent or important e-mails while providing an easy, convenient memory management scheme for the user, as suggested by Haneda (*column 1, lines 43 – 58 and column 2, lines 12 – 15*).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Scannell *et al.* (U.S. Patent No. 5,377,354) disclose a system for sorting and prioritizing incoming electronic mail messages by assigning a priority number to each screened message (*see Abstract and Figs. 1 – 2*).

Larsen *et al.* (U.S. Patent Application Publication No. 2008/0270540) disclose a method of filtering electronic messages wherein, when a sender responds to a reply, a priority is assigned to an insignia (e.g. the e-mail address of the sender) and its associated message (*see Abstract and Fig. 1*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571)272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Myles D. Robinson/
Examiner, Art Unit 2625
5/22/09

/Twyler L. Haskins/
Supervisory Patent Examiner, Art Unit 2625